UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,968	11/21/2003	Louis Corrigan	P66698US1	8014

136   7590   02/08/2008

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ART UNIT	PAPER NUMBER
2152	

MAIL DATE	DELIVERY MODE
02/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/717,968	CORRIGAN ET AL.
	Examiner	Art Unit	
	Dohm Chankong	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-14* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-14* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some *   c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>2/23/2004</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1>   Claims 1-14 are presented for examination.

2>   This is a non-final rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3>   Claim 14 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claim 14 fails to fall within a statutory category of invention. Applicant's specification fails to provide any definition for a "program product." The term is given its broadest reasonable interpretation of "computer product" which is a software computer program (since it comprises software code). Thus, claim 14 is directly to the program product itself, not a process occurring as a result of executing the program, a machine programmed to operate in accordance with the program nor a manufacture structurally and functionally interconnected with the program in a manner which enables the program product to act as a computer component and realize its functionality. Therefore, claim 14 is rejected under 35 U.S.C. §101 for failing to fall within a statutory category.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4> Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1-13 is presumed to invoke 35 U.S.C. §112, sixth paragraph. However, Applicant's specification fails to describe any structure or equivalents thereof that are intended to correspond to the means claimed in the claims.

A claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis (A) the claim limitations must use the phrase "means for" or "step for;" (B) the "means for" or "step for" must be modified by functional language; and (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material; or acts for achieving the specified function. MPEP §2106(I). A claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure described in the specification and equivalents thereof." MPEP §2106(II). "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly

claim the invention as required by the second paragraph of section 112." MPEP

§2106(II) (citing In re Donaldson, 16 F.3d 1189, 1195 (Fed. Cir. 1994) (in banc)).

Here, claims 1-13 meets all three prongs of the analysis. The claim limitations

clearly have "means for" language and the "means for language" is modified solely by

functional language. Additionally, the claim limitations are not modified by any

structure or acts for achieving the specified function. Therefore, claims 1-13 are

presumed to invoke 35 U.S.C. 112, sixth paragraph. However, Applicant's specification

lacks any description of structure corresponding to the "means for" language in the

claims. Therefore, claims 1-13 are rejected as failing to particularly point out and claim

the invention.

b.   Claim 1 is also rejected for containing unclear language. Claim 1 recites in part

"a gateway layer comprising means for routing the requests and the responses and for

modifying them...;" it is unclear whether "them" is intended to refer solely to

requests, to responses, or to both.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5>   Claims 1-11 and 14 are rejected under 35 U.S.C §102(e) as being anticipated by Jiang et

al, U.S Patent No. 7.092.370 ["Jiang"].

6>   As to claims 1 and 14, Jiang discloses a messaging gateway [Figure 2 «item 104»],

comprising:

a network node layer comprising means for interfacing with user mobile devices of a

plurality of different communication standards to receive content or service requests from

the mobile devices and to route responses to the devices [Figure 2 «item 202» where : the

different mobile devices communicate with the various gateways within the network

integration layer];

a gateway node layer comprising means for routing the requests and the responses

and for modifying them according to device technology and content attributes [Figure 2

«item 204» | column 6 «lines 44-54» where : the navigation service within the gateway node

layer routes data in two directions]; and

an application access node layer comprising means for accessing content servers and

application servers [Figure 2 «item 208» where the integration layer provides access to the

customer systems | column 5 «line 65» to column 6 «line 3»].

7>   As to claim 2, Jiang discloses that the network node layer comprises means for

managing the context for a device making a request [column 6 «lines 5-11» : device requests

routed to specific services based on the device's protocol], and for converting an input into a Web request using input data, device context, and application context [Figure 2 «item 202» where : the various gateways translate requests from their respective protocols (WAP, VoiceXML) to HTTP requests | Figure 4 «items 410, 418, 420» | column 32 «lines 3-10 » where the location gateway also performs format conversion].

8>   As to claim 3, Jiang discloses the network node layer comprises means for adding user and location context to requests [Figure 2 «item 202» : location gateway | column 31 «lines 18-58»].

9>   As to claim 4, Jiang discloses the network node layer comprising means for translating responses into a device-specific format using response date, device context, and application context [column 6 «line 64» to column 7 «line 1» : customized response based on when the request is sent, the device type and application type].

10>   As to claim 5, Jiang discloses the network node layer comprising means for updating and storing context between device interactions [column 6 «lines 61-64»].

11>   As to claim 6, Jiang discloses the network node layer comprising a plurality of adapters, each associated with a type of mobile device [Figure 2 «item 202» : each gateway associated with a mobile device based on protocol (WAP, VoiceXML, SMS)].

12>   As to claim 7, Jiang discloses the gateway node layer comprises means for controlling

access to Web applications according to user subscription [column 7 «lines 32-39» | column 9

«lines 41-44»], in which responses are split up and routed according to adapter capabilities,

content attributes, and user-specified rules [Figure 22 «item 2210» | column 9 «lines 45-59» :

response is routed based on user's desire to have "wireless ticketing" and on the type of event

(content attribute)].

13>   As to claim 8, Jiang discloses the gateway node layer comprises means for managing a

register of adapter capabilities and of currently accessible adapters for each user [Figure 204

where : Jiang's gateway layer contains cookie, device, and session management | Figure 16

«items 1610, 1612, 1616» | figure 22 where : Jiang keeps track of the device type which refer to

the adapters that the device can access].

14>   As to claim 9, Jiang discloses the gateway node layer comprises means for translating

service values placed by applications, and for routing the translated data to external systems [

15>   As to claim 10, Jiang discloses the application access node layer comprises means for

an API to allow alternative interfaces for interactive applications [column 35 «lines 45-52»].

16>   As to claim 11, Jiang discloses the network node layer, the gateway node layer, and the

application access node layer comprise means for communicating with each other using an

XML-compliant markup language [column 8 «lines 26-31» : actionable data is represented as XML data on the messaging platform].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17> Claims 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang, in view of Aegerter, U.S Patent Publication No. 20020069182.

18> As to claim 12, Jiang discloses a markup language, t| he content is defined in elements [column 20 «lines 50-60»], but does not expressly disclose that a root element is an abstraction of a mobile device screen. However, such a feature was well known in the art at the time that Applicant's invention was made. Aegerter is directed to a system for enabling rapid creation and deployment of user interfaces for mobile devices [abstract] using an XML-compliant markup language [0090].

Aegerter expressly discloses a root element defined as an abstraction of a mobile device screen [Figure 5b | 0133 where : Aegerter discloses a root node that refers to a servo template that is an abstraction of the mobile device interface]. It would have been obvious to one of ordinary skill in the art to have modified Jiang to include Aegerter's teachings.

Aegerter improves Jiang's system by enabling programmers to more quickly develop mobile device interfaces [Aegerter, 0035].

19>   As to claim 13, Jiang does not expressly disclose sound streams and images are defined as elements. However, such as feature was well known in the art at the time of Applicant's invention. Aegerter discloses sound streams and images defined as elements of an XML-compliant language [0068, 0144]. It would have been obvious to one of ordinary skill in the art to have incorporated Aegerter's teachings into Jiang's system. one would have been motivated to modify Jiang in order to enable programmers to define images and sounds as user interface elements.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Nessett et al, U.S Patent No. 6.055.236 : Figure 2 - layers of a protocol stack;

Doviak et al, U.S Patent No. 6.198.920 : Figure 37 - layered stack of a gateway;

Cai et al, U.S Patent Publication No. 2001|0016880 - Figure 1 - gateway with multiple layers to route messages from mobile devices;

Kailamaki et al, U.S Patent Publication No. 2002|0049675 – Figure 2;

Helgeson et al, U.S Patent No. 7.072.934 – Figure 17 «"SABA Business Platform"» and corresponding text;

Giese, U.S Patent No. 6.621.895 : Figure 1 - different layers responsible for routing messages;

Nykänen et al, U.S Patent No. 6.714.778 : abstract - context-based mobile services;

Henn et al, U.S Patent No. 6.859.879 : Figure 3 – device adaptation layer;

Gouge et al, U.S Patent No. 6.931.429 : Figure 7 ;

Park, U.S Patent No. 6.937.588 : Figure 2B – WAP gateway that routes WAP requests to a web server;

Theeten, U.S Patent No. 6.968.553 : Figure 4 - network element, gateway, application logic layers;

Klemm et al, U.S Patent No. 7.124.413 : Figure 2;

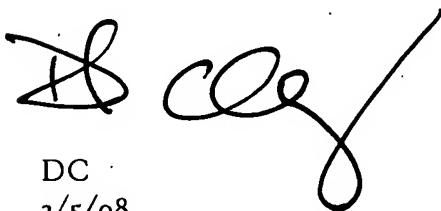Kawamoto et al, U.S Patent No. 7.194.558 : Figure 3;

Huber et al, U.S Patent No. 6.237.261 : Figure 2.

There is also non-patent literature cited in the PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

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